

### **REMARKS**

Claim 1 is currently amended to include elements of claim 1 that were deleted in the previous amendment filed 9/22/08.

Claims 4, 10-12, 15, 16, 19, 24-40, 43, 44, 46-50, 53 and 55-57 are canceled.

Claims 9, 14, 17, 18, 20-23, 41, 42, 54, and 58 were withdrawn by the Office as being directed to a non-elected invention or species.

Accordingly, claims 1-3, 5-8, 13, 45 and 51 are under consideration.

Reconsideration and withdrawal of the rejections are respectfully requested.

#### **Rejections under 35 U.S.C. § 112, First Paragraph**

Claims 12, 15, 47 and 52 were rejected under 35 U.S.C. §112, first paragraph.

Cancellation of claims 12, 15, 47 and 52 render their rejection moot.

#### **Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 13, 15, 47, and 51 were rejected under 35 U.S.C. §112, second paragraph.

In claim 13, the word “step” refers to the phrase “depositing a coating composition on the applicator.” This would be clearly understood by a person of ordinary skill of the art since claim 13 depends from claim 1, and claim 1 recites “depositing a coating composition on an applicator.” That is, in view of claim 1, it is clear that the word “step” refers to the depositing step recited in claim 1 and that the word “step” does not refer to an “applicator step” as asserted by the Office. Thus, there is no basis of the Office’s alleged lack of antecedent basis.

Cancellation of claims 15 and 47 renders their rejection moot.

Regarding claim 51, the Office states that “it is not clear when the submerging occurs.” Claim 51 recites that “the applicator is partially submerged in a reservoir...” and antecedent basis for the applicator is provided in claim 1 which recites “depositing a coating composition on the applicator.” A person of ordinary skill in the art would understand from

the claims 1 and 51 that the applicator is partially submerged in a reservoir at least during the depositing step. Accordingly, Applicant respectfully requests removal of the rejection.

**Claim Rejections 35 U.S.C. § 103**

***Shekalim***

Claims 1-3, 5-8, 12, 13, 15, 47, and 51-52 were rejected under 35 U.S.C. §103(a) as being unpatentable over US 6,971,813 (“Shekalim”).

**Claim 1**

As indicated above, claim 1 was amended to include elements of claim 1 that were present in the amendment filed 5/23/08, then deleted in the amendment filed 9/22/08. In the amendment filed 5/23/08, claim 1 recited “a tubular implantable medical device rotating in a second direction, wherein the second direction is opposite to the first direction or refers to rotation about an axis that is not parallel to a rotation axis of the applicator.” In the present Amendment, claim 1 was amended to recite “rotating the device in a second direction ... , wherein the rotating in the second direction is about an axis that is not parallel to a rotation axis of the applicator. Therefore, the concept of rotating the device “in a direction not parallel to a rotation axis of the applicator” has been already been considered in claim 1 by the Office.

The elements added to claim 1 were previously considered in the Office Action mailed 7/8/2008 (pages 9 and 11), wherein the Office rejected claim 1 under 35 U.S.C. §112, first paragraph, asserting that “the meaning of ‘or refers to ... axis of the applicator’ is unclear,” under 35 U.S.C. §102 as being anticipated by Shekalim, which is cited again in the present Office Action under §103. Therefore, Applicant respectfully submits that no Request for Continued Examination (RCE) is required to be submitted with this Amendment.

Applicant submits that there is nothing indefinite about “rotating in the second direction is about an axis that is not parallel to a rotation axis of the applicator” as recited in claim 1.

Also, Applicant submits that Shekalim fails to teach “wherein the rotating in the second direction is about an axis that is not parallel to a rotation axis of the applicator,” as recited in claim 1. The Office has not addressed this feature in the present Office Action and in Office Action mailed 7/8/2008. With regard to the coating method taught in Shekalim FIG. 1 (reproduced below), the Office states: “One of skill in the art would know that the same surfaces was not being coated over and over; rather, the applicator is moved from area to area of the stent, either by movement of the applicator or movement of the stent, as taught by ‘813 [Shekalim]” (Office Action mailed 5/12/2009 at 8). As best understood, the Office asserts that elements associated with the “first stripe” and “second stripe” are inherently described by Shekalim and that such teaching would be recognized by a person of ordinary skill in the art. Applicant submits that there is still no express or inherent description in Shekalim of “rotating [the device] in the second direction is about an axis that is not parallel to a rotation axis of the applicator,” as recited in claim 1.

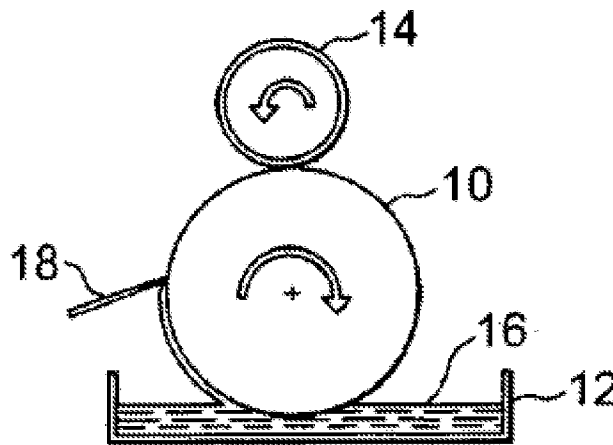


FIG. 1

As person of ordinary skill in the art would not think that Shekalim FIG. 1 (reproduced above) discloses “wherein the rotating in the second direction is about an axis that is not parallel to a rotation axis of the applicator,” as recited in claim 1. Contrary to claim 1, FIG. 1

shows that rotation of the prosthesis (14) is about an axis that is parallel to a rotation axis of the roller (10).

There being no *prima facie* case established, Applicant respectfully submits that claim 1 is patentably over Shekalim.

Claims 2, 3, 5, 7, 8, 13, and 51

Claims 2, 3, 5-8, 13, and 51 depend from claim 1, include all the elements of claim 1, and are patentably allowable for at least the same reasons given above for claim 1.

Claims 12, 15, 47 and 52

Cancellation of claims 12, 15, 47 and 52 renders their rejection moot.

***Shekalim in view of Pinchuk***

Claim 45 was rejected under 35 U.S.C. §103(a) as being unpatentable over Shekalim in view of US 5,9681,091 ("Pinchuk").

As indicated above, claim 1 is patentably allowable over Shekalim. Pinchuk fails to cure the deficiencies of Shekalim with respect to claim 1, so claim 1 is patentably allowable over Shekalim in view of Pinchuk. Claim 45 depends from claim 1, includes all the elements of claim 1, and is patentably allowable over Shekalim in view of Pinchuk for at least the same reasons that claim 1 is patentably allowable.

### CONCLUSION

In light of the foregoing claim amendments and remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 07-1850.

Respectfully submitted,

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/Norman Morales/

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